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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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on November 4, 2005Signature Vivian DelaRosaTyped or printed name Vivian DelaRosa

Application Number

09/905,423

Filed

07/13/2001

First Named Inventor

PATRICK H. HAYES

Art Unit

2677

Examiner

Shapiro, Leonid

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒ attorney or agent of record. 35,906  
Registration number☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34

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November 4, 2005  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

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## REASONS FOR REVIEW REQUEST

In the application claims 7-10 and 13-27 remain pending. Claims 1-6 and 11-12 have been canceled without prejudice.

All of the pending claims presently stand rejected. The reconsideration of the rejection of the claims is respectfully requested.

In the latest Office Action, the pending claims were rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Allport (U.S. Patent No. 6,104,334) in view of Takechi (U.S. Patent No. 6,104,334) in further view of O'Toole (U.S. Patent No. 6,757,723). In rejecting the claims, the Office Action asserted that Allport teaches entering into a hand-held device data that functions to identify a consumer appliance and using the data at the Web server to retrieve an electronic document (IR command library) for the purpose of operating the consumer appliance and that Takechi teaches an electronic document comprising human-readable information describing how to interact with one or more controls of the consumer appliance for the purpose of operating the consumer appliance. While the Office Action acknowledged that both Allport and Takechi fail to disclose uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server and using the data that functions to identify the consumer appliance, the Office Action asserted that O'Toole teaches uploading data that functions to identify an appliance from a device to a Web Server and using the data. Thus, the Office Action concluded that it would have been obvious to modify the combined Takechi and Allport system in view of O'Toole "in order to obtaining configuration information from source located far away."

In response it is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn for the reasons that the cited references fail to present a *prima facie* case of obviousness.

As set forth above, the rejection of the claims relies upon the alleged disclosure within Allport of “entering into a hand-held device **data** that functions to identify a consumer appliance” and “using the data at the Web server to retrieve an electronic document (IR command library) for the purpose of operating the consumer appliance.” While the rejection of the claims relies upon this alleged disclosure within Allport, it is important to note that the Office Action contradicts itself and later acknowledges that Allport, in fact, fails to disclose using “the data” (i.e., “the data” entered into a hand-held device that functions to identify a consumer appliance) at the Web server to retrieve an electronic document (or anything else). Thus, since it has been acknowledged in the Office Action that “Allport and Takechi et al. do not show uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server, using the data that functions to identify the consumer appliance,” it is respectfully questioned how it be said that the claimed invention would have been arrived at by modifying the “uploading and identifying in Takechi et al. and Allport system in view of the teaching in O’Toole et al. in order to obtaining configuration information from source located far away” when it has been acknowledged that Takechi and Allport simply do not disclose, teach, or suggest “uploading and identifying” in the first instance. For this reason, it is submitted that the rejection of the claims fails to present a *prima facie* case of obviousness and the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

Despite this deficiency in the rejection of the claims, it is further respectfully submitted that the rejection of the claims must be withdrawn for the reason that O’Toole is non-analogous

art and, even assuming that O'Toole is analogous art (which it is not), for the reason that O'Toole nevertheless fails to have the disclosure required to maintain a *prima facie* case of obviousness.

As concerns O'Toole being non-analogous art, it is well settled that "in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). With respect to the first criteria used to determine relevance of a prior art reference it cannot be argued that the method for booting an appliance and obtaining configuration information disclosed within O'Toole is in the field of remote controls, i.e., the field of the claimed endeavor. This is evidenced by, among other things, the USPTO classifications of O'Toole as compared to the USPTO classifications of the subject application for patent. With respect to the second criteria used to determine relevance of a prior art reference, it is submitted that the disclosure within O'Toole would not have commended itself to the inventor's attention in considering the problem the subject invention solves, i.e., the problem solved by the subject invention has nothing to do with booting an appliance and configuring an appliance to communicate on a network. Thus, for these reasons it is submitted that O'Toole is non-analogous art and the rejection of the claims must be withdrawn. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

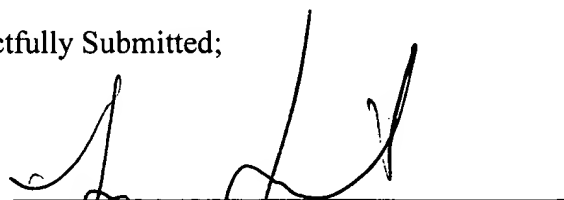
Considering now the disclosure within O'Toole, without regard to whether or not this disclosure is even relevant to the determination of obviousness (which it is not), it is submitted

that O'Toole simply fails to have any disclosure that can be said to support a *prima facie* case of obviousness. In this regard, O'Toole discloses nothing more than a system in which an appliance registers itself with a local area network to thereby allow the appliance to be configured to use the local area network. O'Toole does not disclose, teach, or suggest, however, that which has been acknowledged to be missing from Allport and Takechi. O'Toole does not disclose, teach, or suggest "uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server, using the data that functions to identify the consumer appliance." Thus, since the disclosure within O'Toole of an appliance that registers itself with a network to "[obtain] configuration information from a source located far away" cannot be said to suggest the desirability of modifying Allport and Takechi to include those elements that have been acknowledged to be missing from Allport and Takechi and since modifying Allport and Takechi to include the O'Toole appliance that registers itself with a local area network for the purpose of allowing the appliance to "[obtain] configuration information from a source located far away" as espoused in the rejection simply fails to result in a system that includes each and every element that is set forth in the claims, it is respectfully submitted that the combination of Allport, Takechi, and O'Toole cannot be said to present a *prima facie* case of obviousness. For this still further reason it is submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

Respectfully Submitted;

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By:



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